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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
10/799,532	03/12/2004	Pierre Potier	1054-04	8499

35811 7590 01/26/2005

IP GROUP OF DLA PIPER RUDNICK GRAY CARY US LLP  
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EXAMINER

CARR, DEBORAH D

ART UNIT

PAPER NUMBER

1621

DATE MAILED: 01/26/2005

Please find below and/or attached an Office communication concerning this application or proceeding.

<b>Office Action Summary</b>	<b>Application No.</b>	<b>Applicant(s)</b>
	10/799,532	POTIER ET AL.
Examiner	Art Unit	
Deborah D Carr	1621	

-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If the period for reply specified above is less than thirty (30) days, a reply within the statutory minimum of thirty (30) days will be considered timely.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

## Status

1)  Responsive to communication(s) filed on 27 October 2004.

2a)  This action is FINAL.                            2b)  This action is non-final.

3)  Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

## **Disposition of Claims**

4)  Claim(s) 1-30 is/are pending in the application.  
4a) Of the above claim(s) 1-24 is/are withdrawn from consideration.  
5)  Claim(s) \_\_\_\_\_ is/are allowed.  
6)  Claim(s) 25-30 is/are rejected.  
7)  Claim(s) \_\_\_\_\_ is/are objected to.  
8)  Claim(s) \_\_\_\_\_ are subject to restriction and/or election requirement.

## Application Papers

9)  The specification is objected to by the Examiner.

10)  The drawing(s) filed on \_\_\_\_\_ is/are: a)  accepted or b)  objected to by the Examiner.

    Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).

    Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).

11)  The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

**Priority under 35 U.S.C. § 119**

12)  Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).

a)  All    b)  Some \* c)  None of:

1.  Certified copies of the priority documents have been received.
2.  Certified copies of the priority documents have been received in Application No. \_\_\_\_\_.
3.  Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).

\* See the attached detailed Office action for a list of the certified copies not received.

**Attachment(s)**

- 1)  Notice of References Cited (PTO-892)
- 2)  Notice of Draftsperson's Patent Drawing Review (PTO-948)
- 3)  Information Disclosure Statement(s) (PTO-1449 or PTO/SB/08)  
Paper No(s)/Mail Date

4)  Interview Summary (PTO-413)  
Paper No(s)/Mail Date. \_\_\_\_ .

5)  Notice of Informal Patent Application (PTO-152)

6)  Other: \_\_\_\_ .

DETAILED ACTION

*Election/Restrictions*

1. Claims 1-24 withdrawn from further consideration pursuant to 37 CFR 1.142(b) as being drawn to a nonelected invention, there being no allowable generic or linking claim. Election was made without traverse in the reply filed on 27 October 2004.

*Claim Rejections - 35 USC § 102*

2. The following is a quotation of the appropriate paragraphs of 35 U.S.C. 102 that form the basis for the rejections under this section made in this Office action:

A person shall be entitled to a patent unless –

(a) the invention was known or used by others in this country, or patented or described in a printed publication in this or a foreign country, before the invention thereof by the applicant for a patent.

3. Claims 25-29 rejected under 35 U.S.C. 102(a) as being clearly anticipated by Maignan et al. (US. Pat. 6,514,507).

US'507 teaches the use of the instant compounds in the treatment of intrinsic or extrinsic aging of the skin. As shown in col. 1, lines 29-55 intrinsic or extrinsic aging includes degradation of collagen fibers. These compounds are also disclosed to be able to regenerate the epidermis. The mode that is cited for all of these aging ailments are collagen that as cited supra can be treated using the compound taught by US'507. The ability to treat these aging diseases is considered to be an inherent property of these compounds.

*Claim Rejections - 35 USC § 103*

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4. The following is a quotation of 35 U.S.C. 103(a) which forms the basis for all obviousness rejections set forth in this Office action:

(a) A patent may not be obtained though the invention is not identically disclosed or described as set forth in section 102 of this title, if the differences between the subject matter sought to be patented and the prior art are such that the subject matter as a whole would have been obvious at the time the invention was made to a person having ordinary skill in the art to which said subject matter pertains. Patentability shall not be negated by the manner in which the invention was made.

5. Claim 30 rejected under 35 U.S.C. 103(a) as being unpatentable over Kameda et al.

The invention as claimed supra reads on a method of reducing weight in a patient in need thereof by administrating a unsaturated hydroxyl fatty acid of the instant invention.

Kameda et al. discloses compounds that read on the instant invention, namely trans-10-hydroxy-2 decanoic acid (HDA) that decreases lipolysis. The reference differs from the claims by not stating that the compounds can be used to reduced weight.

However, it would have been obvious to one of any skill in the art at the time that the invention was made to extrapolate that the instant compounds namely HDA could be used in reducing weight in a patient in need thereof.

It is disclosed on pages 10-11 of the specification, HDA have lipolytic activity and can be employed in weight reduction treatments and in any treatment known to require a lipolytic activity. An ordinary artisan would have the reasonable expectation that the HDA disclosed by Kameda being the same compound as the instant invention would have the similar if not the same properties and, thus, the same use as the instant claim.

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6. The following is a quotation of the first paragraph of 35 U.S.C. 112:

The specification shall contain a written description of the invention, and of the manner and process of making and using it, in such full, clear, concise, and exact terms as to enable any person skilled in the art to which it pertains, or with which it is most nearly connected, to make and use the same and shall set forth the best mode contemplated by the inventor of carrying out his invention.

7. Claims 25-30 rejected under 35 U.S.C. 112, first paragraph, because the specification, while being enabling for trans-10-hydroxy-2 decanoic acid, does not reasonably provide enablement for the cis-10-hydroxy-2 decanoic acid. The specification does not enable any person skilled in the art to which it pertains, or with which it is most nearly connected, to use the invention commensurate in scope with these claims.

As stated throughout the specification specifically on page 10, the instant invention pertains to the used of trans-10-hydroxy-2 decanoic acid. There is no indication that the cis form of this compound is embraced as neither an invention nor its use in treating the disclosed diseases.

8. Any inquiry concerning this communication or earlier communications from the examiner should be directed to Deborah D Carr whose telephone number is 571-272-0637. The examiner can normally be reached on Monday-Friday 8:30-5:00.

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Johann Richter can be reached on 571-272-0646. The fax phone number for the organization where this application or proceeding is assigned is 703-872-9306.

Information regarding the status of an application may be obtained from the Patent Application Information Retrieval (PAIR) system. Status information for published applications may be obtained from either Private PAIR or Public PAIR. Status information for unpublished applications is available through Private PAIR only. For more information about the PAIR system, see <http://pair-direct.uspto.gov>. Should you have questions on access to the Private PAIR system, contact the Electronic Business Center (EBC) at 866-217-9197 (toll-free).



DEBORAH D. CARR  
PRIMARY EXAMINER

ddc